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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,574	11/28/2003	Karl-Heinz Wendt	1085-029	8642
47888	7590	03/31/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			CAMERON, ERMA C	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 03/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/724,574

Applicant(s)

WENDT, KARL-HEINZ

Examiner

Erma Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,8,10-12,15-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,10-12,15-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments filed 1/17/2006 have been fully considered but they are not fully persuasive.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

“...deposits...from later contamination prior or after the cleaning and /or coating step...” is new matter that was not in the specification as originally filed.

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“...pointed edges formed during or after the curing step...” is new matter that was not present in the specification as originally filed.

The applicant is requested to cancel new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 8, 10-12, 15-17 and 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1, second last line: it is not clear which coating is meant, the coating formed from the cleaning and/or coating step, or the acrylate lacquer.

b) Claim 15 and 26: because ester and alkoxy ester overlap, this claim is vague.

*Claim Objections*

6. The objection to Claim 6 under 37 CFR 1.75(c), is withdrawn because of the cancellation of claim 6.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The rejection of Claims 1-3, 5-16 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bock et al (6020419) is withdrawn because of the amendment filed 1/17/2006.

The particle size of '419 is under the limitations of the instant claims.

9. Claims 1-5, 8, 10-12, 15-16 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937.

'252 teaches a 2-pack coating composition for glass that comprises an acrylic polymer and a polyisocyanate with at least two isocyanate groups (2:21-54). Solvents such as alcohols such as isopropanol or ester solvents may be present (9:31-47) at up to 40 wt%. There is present

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coloring or metallic pigments (10:1-5). The composition is applied by spraying and other means, and the film thickness is 1-1000 microns, which overlaps with applicant's claimed thickness (10:6-10). After application to glass, the composition is cured (12:49-58).

'252 does not teach cleaning or priming the glass first, but it is conventional to at least clean a surface before applying another layer. It is also conventional to mask an area to be coated.

'252 teaches to apply the composition to glass in general, which would be inclusive of fire-resistant, composite or safety glass.

The surface tension would be inherent to the coating used.

'252 does not teach the particle size of the coloring or metallic pigments.

'937 teaches that the addition of reflective particles such as aluminum or TiO<sub>2</sub> in the 10-100 micron size provides good reflective properties for a glass coating.

It would have been obvious to one of ordinary skill in the art to have used the reflective particles of 10-100 micron size as taught by '937 in the '252 process because of the teaching of '937 that such particles have good reflective properties.

Regarding applicant's argument that the particle size of '252 is 0.02-0.6 microns (9:12-13), this is the particle size of the dispersed copolymer, not the particle size of the coloring or metallic pigments (10:1-5). Regarding the coating thickness on glass, it is the examiner's opinion that the coating thickness at 12:55-58 is merely exemplary and not a limitation. Regarding the US classification of the US equivalent (5519089), the claims of '089 are composition claims, whereas the claims of the instant application are method of coating claims, classified in class 427.

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10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Ellenson et al (2969328).

'252 and '937 are applied here for the reasons given above.

Neither teaches that the coating would be removable with a halogen containing stripper.

'328 teaches that paints, resin and the like can be removed from glass and other surfaces, if so desired, with halogen containing solvents (1:152:56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have removed the coating of '252, as modified by '937, with the halogen containing composition of '328, if removal was desired.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ERMA CAMERON  
PRIMARY EXAMINER  
March 27, 2006

Erma Cameron  
Primary Examiner  
Art Unit 1762